

REMARKS

In the Official Action, the Examiner made the election of species requirement final and, with respect to the elected claims, rejected claims 1-4, 8 and 10 under 35 U.S.C. §103(a) as being unpatentable over the combination of Guzzi, U.S. Patent No. 4,696,891, and Kawamura et al., U.S. Patent No. 5,731,123. The Examiner only objected to claims 5-7 and 9 and indicated that such claims would be allowable if rewritten in independent form.

By the present Amendment, editorial revisions have been made throughout the application and in claim 9 (where appropriate punctuation has been used) and claim 18 (where the appropriate term has been employed). The substance of the claims, has not been changed, however, since applicants respectfully maintain that the claims of record are patentable over the proposed combination of patents.

As discussed in detail in the specification, one aspect of the present invention relates to a positive planographic printing plate precursor comprising a support having disposed thereon a positive recording layer containing (A) a water-insoluble and alkali-soluble resin, (B) an infrared absorbent and (C) an organic quaternary ammonium salt wherein the solubility of the recording layer in an aqueous alkali solution is increased by exposure to an infrared laser. From the plain words in the claim and the teachings set forth in the specification, those of ordinary skill in the art will appreciate that this embodiment of the present invention utilizes the infrared absorbent generates heat upon exposure of the infrared laser and provides the image so that the precursor can be processed into a printing plate. As set forth on page 7, lines 1-13, the presence of the

organic quaternary ammonium salt provides resistance to alkali development, but such effect is terminated at regions where the infrared absorbent has generated heat due to exposure by the infrared laser.

The defined positive planographic printing plate precursor of the claims under consideration is not rendered obvious by the combination of Guzzi and Kawamura et al. As the Examiner has conceded in the Official Action, Guzzi does not contain a disclosure of an infrared absorbent. This significant deficiency is not a mere oversight, but marks a substantial difference between the claimed aspect of the invention and the material of Guzzi. That is, as specifically set forth in the passage beginning at column 4, line 22, the light sources which can be used to expose the disclosed material are a xenon lamp, a metal halide lamp, or an arc lamp with the metal halide lamp being used in the example described at column 6, lines 27-30. Such light sources are designed to provide ultraviolet light, not infrared light. This understanding can be obtained by considering U.S. Patent No. 4,258,123 at column 8, lines 1-3 and U.S. Patent No. 6,482,570 in the paragraph bridging columns 10 and 11 (copies of the cover page and excerpts attached hereto). Therefore, there is no proper basis for asserting that it would be obvious to use an infrared absorbent in the material of Guzzi. As for the statement in the patent that dyes, indicators or pigments can be used to render the image readily visible, this merely means that some colorant be added so that when the material is developed, one can determine which portions of the original material remain and which portions have been removed. It is clearly not a teaching of using an infrared absorbent as specifically required in claim 1.

Further demonstrating the distinct nature of Guzzi, it will be noted from the description provided in the passage beginning at column 3, line 46 that the quaternary ammonium compound of Guzzi is used as a cross-linking catalyst which is a function entirely different from the aforementioned function of inhibiting alkali development that is described on page 7 of the present application. Thus, this is still further evidence that the material of Guzzi is totally different from that set forth in the claims under consideration.

Kawamura et al. cannot be properly combined with Guzzi. Kawamura et al. describes the presence of an infrared absorbent which is appropriate in view of the infrared laser that can be used which is illustrated at column 41, lines 53-54. However, since Guzzi is designed for exposure by UV radiation, it would not be obvious to use the infrared absorbent of Kawamura et al. in the material of Guzzi. Indeed, the only basis for making such a selective combination would be based on applicants' own specification which is clearly improper. In this regard, it will be further noted that while the presently claimed aspect of the invention and Kawamura et al. relate to positive image formation, Guzzi predominantly relates to negative relief copies (see the title, abstract and claim 1) and can only obtain a positive image using a distinct procedure than that used for negative image formation.

Therefore, while applicants sincerely appreciate the indication of allowability of claims 5-7 and 9, applicants respectfully submit that when all of the noted distinctions are considered, those of ordinary skill in the art can only conclude that the presently claimed invention is patentable over the cited prior art. Accordingly, reconsideration and allowance of the claims are respectfully requested.

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Should the Examiner wish to discuss any aspect of the present application, he is invited to contact the undersigned attorney at the number provided below.

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Date: November 20, 2003